



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| | | | | |
|-----------------|-------------|----------------------|---------------------|------------------|
| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
| 09/762,522 | 02/05/2001 | Maria Altamura | 205 010 | 4796 |

Abelman Frayne & Schwab
150 East 42nd Street
New York, NY 10017-5612

7590

10/29/2003

| | |
|-----------------------|--------------|
| EXAMINER | |
| COLEMAN, BRENDA LIBBY | |
| ART UNIT | PAPER NUMBER |
| 1624 | 15 |

DATE MAILED: 10/29/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.
09/762,522

Examiner

Brenda Coleman

TAMURA et al.

-- The MAILING DATE of this communication appears on the cover sheet with the co
 FILED Sep 29, 2003 FAILS TO PLACE THIS

THE REPLY FILED Sep 29, 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION 24
Therefore, further action by the applicant is required to avoid the abandonment of this application
rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment to the application
allowance; (2) a timely filed Motion to Withdraw from the application.

Therefore, further action by the applicant is required to avoid the abandonment of this application. The applicant must file with the Commissioner, within the time specified in the notice of rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

THE PERIOD FOR REPLY [check only a) or b)]

- a) ☒ The period for reply expires 6 months from the mailing date of the final rejection.

- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply after the mailing date of the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:

2. ☒ The proposed amendment(s) will not be entered because:

- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☒ they raise the issue of new matter (see NOTE below);
- (c) ☐ they are not

- (b) ☒ they raise the issue of new matter (see NOTE below);

- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without

- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.
- NOTE: see attached Advisory Action.

NOTE: see attached Advisroy Action.

3. ☐ Applicant's reply has overcome the following rejection(s):

4. ☐ Newly proposed or amended claim(s) _____
a separate, timely filed amendment canceling the non-allowable claim(s). _____ would be allowable if submitted in
5. ☐ The a) ☐ affidavit b) ☐ _____

5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because:

6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed:

Claim(s) objected to:

Claim(s) rejected:

Claim(s) withdrawn from consideration:

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.

9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). ☐ approved or ☐ disapproved by the Examiner.
0. ☐ Other: *Branch C-2*

10. ☐ Other:

**BRENDA COLEMAN
PRIMARY EXAMINER
ART UNIT 1624**

Advisory Action

Art Unit: 1624

ADVISORY ACTION

Claims 21-33 are pending in the application.

The period for reply continues to run SIX MONTHS from the date of the final rejection. Any extension of time must be obtained by filing a petition under 37 CFR 1.136(a) accompanied by the appropriate fee. The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. A reply within the meaning of 37 CFR 1.113 or a request for a continued examination (RCE) in compliance with 37 CFR 1.114 must be timely filed to avoid abandonment of this application.

The amendment filed September 29, 2003 under 37 CFR 1.116 in response to the final rejection has been considered but is not deemed to place the application in condition for allowance and will **not** be entered because: the new matter presented in the claims of the response filed September 29, 2003 is such that the definition of R_{12} (in claim 21) includes the moiety piperazine optionally substituted on the N-atom by 4-aminosulfonyl and the moiety where R_{12} is C_{1-3} alkyl.

Additionally, the following amendments to the specification and claims raises new issues:

- a) The proposed amendment to the specification at page 4, line 12, fails to give directions to the amendment and appears to be incomplete.
- b) The proposed amendment to the definition of R_{12} appears as such:

Art Unit: 1624

and R₁₂ is chosen among: morpholine, pyrrolidine optionally substituted with an hydroxy or hydroxymethyl, piperidine optionally substituted with a 4-hydroxy or 4-carboxyamido group [**no comma separating**] piperazine optionally substituted on the N-atom by **4-aminosulfonyl [new matter]**, C₁₋₃ **alkyl [new matter]**, triazole, tetrazole, 5-mercapto-tetrazole, furan, thiophene, thiomorpholine, optionally mon- or di-oxygenated on the S-atom, and **cyclohexan-1-yl- [new matter]** optionally substituted by a hydroxy group.

- c) Two of the species in claim 27 lack antecedent basis, i.e. (4-methylphenyl)sulfonylamino in species xxii and xxiii.
- d) Species xxvii in claim 27 contains a typo, i.e. cianomethylamino.

Applicants are reminded that all rejections of the Office Action mailed on April 29, 2003 are herein maintained.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brenda Coleman whose telephone number is (703) 305-1880. The examiner can normally be reached on Mondays and Tuesdays from 9:00 AM to 3:00 PM and from 5:30 PM to 7:30 PM and on Wednesday thru Friday from 9:00 AM to 6:00 PM.

The fax phone number for this Group is (703) 308-4734 for “unofficial” purposes and the actual number for **OFFICIAL** business is **308-4556**.

Application/Control Number: 09/762,522

Page 4

Art Unit: 1624

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1235.

Brenda Coleman

Brenda Coleman
Primary Examiner AU 1624
October 27, 2003